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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		10970975-1	
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on <u>Dec 21 2005</u>		09/517366	Mar 2 2000
Signature <u></u>		First Named Inventor	
Typed or printed name <u>Carrie McKerley</u>		Jeffrey S Barber	
		Art Unit	Examiner
		2194	George L. Opie
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	Philip S. Lyren	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/86)	Typed or printed name	
<input type="checkbox"/>	attorney or agent of record. Registration number <u>40,709</u>	(281) 514-8236	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number	
		Dec 21 2005	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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DEC 21 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	Jeffrey S. Barber et al.	Examiner:	George L. Opie
Serial No.:	09/517,366	Group Art Unit:	2194
Filed:	March 2, 2000	Docket No.:	10970975-1
Title:	System and Method for Establishing a Secure Execution Environment for a Software Process		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants file this Pre-Appeal Brief in response to the Final Office Action dated November 1, 2005. In the Final Office Action, claims 21-30 and 38-40 are rejected under 35 USC § 101 as being directed to non-statutory subject matter. Applicants appeal this rejection.

**Background**

Claims 21-30 and 38-40 recite the following preamble: "A computer readable medium having instructions for causing a computer to execute a method, comprising." In the specification, Applicants provide a lengthy description and examples of various "computer-readable medium." These examples include various media, such as electronic, magnetic, optical, ROM, RAM, etc. The specification also states:

Note that the computer-readable medium could even be paper of another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.  
(Specification at page 6, lines 7-11).

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The Examiner rejects these claims as being non-statutory under 35 USC § 101. Specifically, the Examiner cites several cases related to printed matter and states: "Printed matter which fails to be functionally interrelated to its substrate has long been held to be nonstatutory" (FOA at p. 3).

**Examiner's Rejection Contrary to Case Law**

The rejection of the Examiner directly conflicts with current case law that is precedent in this matter. The Federal Circuit has held that the printed matter cases have no relevance where, as here, the claims recite information readable by a machine. For instance, the Federal Circuit decision in *In Re Lowry* explicitly rejected the notion that printed matter rejections apply to computer readable media:

The printed matter cases "dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind." *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPO 611, 615 (CCPA 1969). The printed matter cases have no factual relevance where "the invention as defined by the claims *requires* that the information be processed not by the mind but by a machine, the computer." *Id.* (Emphasis in original: *In Re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994)).

As yet another example, the Federal Circuit decision in *In re Beauregard* expressly stated that the printed matter doctrine does not apply to computer program product claims (see *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)). In order to advance prosecution, Applicants even amended the rejected claims to emulate the preamble expressly allowed in *In re Beauregard*. Despite this amendment, the Examiner has refused to withdraw the rejection under 35 USC § 101.

Thus, the Federal Circuit has expressly held that the printed matter cases have no relevance here (*In re Lowry* at 1583). More specifically, claims 21-30 and 38-40 require that information is processed, not by the mind, but by a machine. In fact, the body of independent

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claim 21 even recites computer elements such as "operating a software process on a computer" and "executing an operating system kernel in communication with the software process."

In light of the legal precedent in the Federal Circuit, Applicants respectfully ask the Board of Appeals to reverse the rejection of claims 21-30 and 38-40.

#### **Response to Examiner's Case Law Citations**

The Examiner cites several cases in an attempt to support his position that the printed matter cases apply to the computer readable medium of claims 21-30 and 38-40. Applicants disagree with the Examiner's interpretation of these cases. In fact, Applicants argue that these cases actually support patentability of computer readable medium claims.

As one example, the Examiner cites *In re Jones*. This decision supports the position of the Applicants. In this case, the court stated:

We think it is error to confuse the lines on a patent drawing, which may have the appearance of "printed matter," with functional elements of a mechanism which in use actuate other mechanism or electrical circuits or devices intended to be illustrated by the drawing. (*In re Jones*, 373 F. 2d 1007, at 1013).

As noted above, the body of independent claim 21 recites numerous elements for performing operations on a computer ("operating a software process on a computer" and "executing an operating system kernel in communication with the software process" etc.). Further yet, the portion of the specification that mentions a computer-readable medium as being paper even expressly states that the printed program performs operations on a computer:

[T]he computer-readable medium could even be paper of another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory. (Emphasis added).

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Thus, the CCPA decision in *In Re Jones* cited by the Examiner does not support the rejection. Rather, *Jones* is consistent with the Federal Circuit's holding in *Lowry* that computer readable printed paper as recited in the rejected claims is not subject to a printed matter rejection.

#### **Rejected Claims Meet Criteria of § 101**

Under 35 USC § 101, patentable subject matter must have two basic criteria. First, the subject matter must be one of processes, machines, manufacturers, and compositions of matter. Generally, three categories are not included as patentable subject matter: (1) abstract ideas, (2) laws of nature, and (3) natural phenomena. Second, the subject matter to be patented must be "useful." Applicants' claimed subject matter meets both of these criteria.

First, as noted above, the Federal Circuit has clearly held that computer readable medium are statutory subject matter according to 35 USC § 101 (see *Lowry*). Second, the Examiner has made no argument whatsoever that claims 21-30 and 38-40 are not useful within the meaning of 35 USC § 101.

#### **Conclusion**

In short, claims 21-30 and 38-40 meet the requirements of 35 USC § 101. The Office Action contends that since Applicants' specification states that a computer readable medium includes a piece of paper, claims 21-30 and 38-40 are directed to non-statutory subject matter. This argument is improper. The Examiner is not properly applying the law of 35 USC § 101. Further, Applicants respectfully argue that the Examiner is not following the U.S. Patent and Trademark Office's own guidelines for software cases (see, *Examination Guidelines for Computer-Related Inventions*). The Examiner has not followed these guidelines in rejecting the claims under Section 101.

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For at least these reasons, Applicants request withdrawal of the final rejection.

Respectfully submitted,



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CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 21<sup>st</sup> day of December, 2005.

By



Name: Carrie McKerley